



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/252,485	02/18/1999	JOHN S. HENDRICKS	5615	4559

7590 07/23/2003

ALDO NOTO  
DORSEY & WHITNEY  
1001 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER

GRANT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 07/23/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/252,485

Applicant(s)

HENDRICKS ET AL.

Examiner

Christopher Grant

Art Unit

2611

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

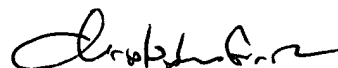
Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 2-6, 16-20, 22-25, 34-40, 42, 43, 46-55, 57, 60-64, 66, 67, 69, 71-76.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_



Christopher Grant  
Primary Examiner  
Art Unit: 2611

Continuation of 2. NOTE: 2. (a) The deletion of the term "at least" changes the scope of the claims. (i.e. the amendments raise new issue that would require further consideration and/or search).

2. (b) The amendments and/or the subject matter of claim 42 raise the issue of new Matter as described in the Office Action mailed 4/10/2003 at pages 2-6. See the Examiner's response below.

2. (c) The amendments are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. See the Examiner's response below.

Applicant's arguments filed 6/24/2003 have been fully considered but they are not persuasive.

(A) Applicant pointed to page 17, lines 1-5 of the disclosure including the statement "The preferred upgrade is a circuit card with a microprocessor which is electronically connected or inserted into the converter box." on page 5 of the amendment filed 6/24/2003.

(Response) First, the Examiner posits that page 17, lines 1-5 of the disclosure is referring to figures 12a and 12b that describe upgrade cards (100, 130 respectively) each having a microprocessor separate from the microprocessor in the set top terminal (220, 200 respectively).

Secondly, figure 14 only has one microprocessor (602). The statement at page 17, lines 1-5 describe an upgrade circuit card with a microprocessor. Since, figure 14 has one microprocessor and not two microprocessors (as suggested), the Examiner contends that there is no nexus with the statement at page 17 and figure 14.

B) Applicant stated that page 21, line 16 - page 22, line 2 and figure 4 provide detailed description of the preferred set top terminal 220. In response, the Examiner agrees that figure 4 provides a detailed description of a set top terminal and that it appears to resemble the upper portion of figure 14 (i.e. "the claimed first signal processing components"). However, Applicant has merely provided a correlation of one set of components between figures 4 and 14. There is no discussion of the particular components in figure 14 that are included in a hardware upgrade. More importantly, there is no discussion of any particular components in an upgrade card insertable into an existing set top terminal to provide digital picture in picture as now claimed.

C) In response to Applicant's arguments at page 6, beginning at line 6 of the amendment, the Examiner posits that the passage at page 49, lines 12-15 describes a set top terminal in figure 14.

Other than the similarity of components of the upper portion of figure 14 to figure 4, there is no teaching in figure 14 of an upgrade card insertable into an existing set top terminal to provide digital picture in picture.

The passage at page 49, lines 12-15 describe an upgrade hardware not an upgrade card insertable into an existing set top terminal.

The passage at page 44, lines 21-25 of the disclosure is made in reference to figures 5a and/or 5b having expansion card slots. There is no correlation of the components with figures 5a and 5b with figure 14.

Figure 14 have an expansion card interface (322) and upgrade port (662). Therefore, it appears that an upgrade card is insertable into the interface (322) or the port (662) as illustrated in figure 14. As a result, the claimed second signal processing components (603', 606, 609 605', 314', 318', 618', 625' etc.) appear to be a part of a set top terminal (figure 14) and not on or apart of an insertable upgrade card.

Finally, the specification and drawings fail to describe the boundary, contents or components of the upgrade hardware in relation to figure 14.

For all the reasons given above, the Examiner posits that Applicant's arguments are not persuasive.